



In re Application of

Lasken *et al.*

Application No.: 09/920,571

Filing Date: July 31, 2001

For: MULTIPLY-PRIMED AMPLIFICATION
OF NUCLEIC ACID SEQUENCES

Art Unit: 1637

Examiner: Teresa E. Strzelecka

Confirmation No.: 4875

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer Number 23859

Dear Sir:

Pursuant to the requirements of 37 C.F.R. § 1.56, Applicants now submit a list of documents known to Applicants or Applicants' attorneys. In view of the Federal Circuit Court of Appeals' decision in *McKesson Information Solutions, Inc. v. Bridge Medical Inc.*, 487 F.3d 897 (Fed. Cir. 2007), Applicants also provide a list of documents from the prosecution of foreign and U.S. patent applications.

Applicants have not included copies of cited U.S. patents or published U.S. patent applications. But, pursuant to 37 C.F.R. § 1.98(a)(2)(iv), and for the Examiner's review, Applicants have enclosed copies of the following: (1) cited foreign patents, (2) non-patent publications, and (3) documents from the prosecution of foreign and U.S. patent applications.

Regarding category (3), documents from the prosecution of foreign and U.S. patent applications, Applicants note that 37 C.F.R. § 1.98(b) does not mention, and thus does not

require, that Applicants must provide any particular set of identifying information. While 37 C.F.R. § 1.98(a)(1) requires Applicants to provide a list of such documents, it does not require Applicants to include in that list specific identifying information. 37 C.F.R. § 1.98(a)(2)(iv) further requires Applicants to provide a copy of such documents (see APPENDIX A). Thus, the rules do not require that Applicants provide any particular set of information about the documents in category (3) prior to the Examiner's consideration of all the cited information. Nevertheless, in order to be as helpful as possible, Applicants have provided (a) information regarding the source of the documents, and (b) a title or description of each document. The prosecution record of either a foreign patent application or a U.S. patent application is the source for each document. Accordingly, in the list required by 37 C.F.R. § 1.98(a)(1), Applicants have provided information about the source of each document. The information provided mirrors the requirements for cited foreign patent applications and U.S. patent applications as set forth by 37 C.F.R. § 1.98(b). For at least these reasons, Applicants respectfully request consideration of all documents submitted in the present Information Disclosure Statement.

Pursuant to M.P.E.P. § 2001.06(b) and 37 C.F.R. § 1.98(b)(3), Applicants now bring to the attention of the Examiner the following co-pending U.S. patent applications. The pending applications identified with an asterisk (*) are stored in the USPTO's Image File Wrapper (IFW) system. In accordance with the waiver to 37 CFR § 1.98(a)(2)(iii) dated September 21, 2004, Applicants have not included copies of the cited specifications, which include the claims and drawings thereof.



INFORMATION DISCLOSURE STATEMENT LIST pursuant to M.P.E.P. § 2001.06(b) and 37 C.F.R. § 1.98(b)(3) for Application No. 09/920,571 (Attorney Docket #: 17104.0001U2) DISCLOSURE OF CO-PENDING U.S. PATENT APPLICATIONS					
Initials	No. Cited	U.S. Patent Application #	Filing Date	First Inventor	Attorney Docket #
	1	*11/871707	10/12/2007	Bornarth, C.	13172.0012U5
	2	*10/072,666	02/08/2002	Kumar, G.	13172.0015U1
	3	*10/325,665	12/19/2002	Alsmadi, O.	13172.0018U1
	4	*10/405,822	3/31/2003	Abarzua, P.	13172.0023U1
	5	*10/700,018	11/03/2003	Lizardi, P.	25006.0003U4
Initials	No. Cited	U.S. Publication No.	Publication Date	First Inventor	Attorney Docket #
	1	* US-2006-0166227-A1	07/27/2006	Kingsmore, S.	13172.0004U3
	2	* US-2004-0248103-A1	12/9/2004	Feaver, W.J.	13172.0024U1
	3	* US-2008-0096258-A1	4/24/2008	Korfhage, C.	17104.0011U2
	4	* US-2004-0265897-A1	12/30/2004	Lizardi, P.	25006.0001U6

Applicants submit for the Examiner's consideration, copies of Office Actions, Amendments, Responses, and other correspondence from the prosecution of the following U.S. patent applications. Pursuant to 37 C.F.R. § 1.98(a)(2)(iv), Applicants have enclosed a copies of each document. APPENDIX A lists these documents, provides identifying information, and includes a column for the Examiner's initials.

INFORMATION DISCLOSURE STATEMENT LIST pursuant to 37 C.F.R. § 1.98(a)(1)-(2) and (b)(3) for Application No. 09/920,571 (Attorney Docket #: 17104.0001U2) Disclosure of U.S. Patent Applications for which Applicants provide prosecution-related documents (see APPENDIX A)					
Initials	No.	U.S. Patent Application #	Filing Date	First Inventor	Attorney Docket #
	1.	09/803713	3/9/2001	Alsmadi, O.A.	13172.0002U1
	2.	10/325490	12/19/2002	Alsmadi, O.A.	13172.0002U2
	3.	10/404944	3/31/2003	Alsmadi, O.A.	13172.0002U3
	4.	09/547757	4/12/2000	Faruqi, A.F.	13172.0003U1
	5.	09/597836	6/20/2000	Kingsmore, S.	13172.0004U1
	6.	10/341287	1/13/2003	Kingsmore, S.	13172.0004U2
	7.	11/187537	07/22/2005	Kingsmore, S.	13172.0004U3
	8.	09/897259	7/2/2001	Ward, D.C.	13172.0005U2
	9.	09/910383	07/20/2001	Nallur, G.	13172.0007U1
	10.	09/977868	10/15/2001	Bornarth, C.	13172.0012U1
	11.	09/982212	10/18/2001	Bornarth, C.	13172.0012U2
	12.	10/272465	10/15/2002	Bornarth, C.	13172.0012U3
	13.	10/429229	05/02/2003	Bornarth, C.	13172.0012U4
	14.	08/754681	11/21/1996	Lizardi, P.	13172.0013U2
	15.	09/602428	6/23/2000	Lizardi, P.	13172.0013U3
	16.	09/841513	4/24/2001	Lizardi, P.	13172.0013U4
	17.	10/413041	4/10/2003	Lizardi, P.	13172.0013U5
	18.	10/072666	02/08/2002	Kumar, G.	13172.0015U1
	19.	09/460078	12/14/1999	Hafner, G.	13172.0017U2
	20.	10/917580	08/13/2004	Hafner, G.	13172.0017U3
	21.	10/325665	12/19/2002	Alsmadi, O.	13172.0018U1
	22.	10/335573	12/31/2002	Kumar, G.	13172.0021U1
	23.	11/201339	08/10/2005	Kumar, G.	13172.0021U2
	24.	10/405,822	03/31/2003	Abarzua, P.	13172.0023U1
	25.	10/454946	06/04/2003	Feaver, W.J.	13172.0024U1
	26.	09/605192	6/28/2000	Lasken, R.	17104.0001U1

INFORMATION DISCLOSURE STATEMENT LIST pursuant to 37 C.F.R. § 1.98(a)(1)-(2) and (b)(3) for Application No. 09/920,571 (Attorney Docket #: 17104.0001U2) Disclosure of U.S. Patent Applications for which Applicants provide prosecution-related documents (see APPENDIX A)					
Initials	No.	U.S. Patent Application #	Filing Date	First Inventor	Attorney Docket #
	27.	09/577444	5/24/2000	Kingsmore, S.	17104.0002U2
	28.	09/897665	7/2/2001	Kingsmore, S.	17104.0002U3
	29.	09/910372	7/20/2001	Bandaru, R.	17104.0003U2
	30.	10/465759	6/19/2003	Bandaru, R.	17104.0003U3
	31.	09/723685	11/28/2000	Abarzua, P.	17104.0004U2
	32.	10/196539	7/16/2002	Abarzua, P.	17104.0004U3
	33.	11/429549	5/5/2006	Abarzua, P.	17104.0004U4
	34.	09/827289	4/5/2001	Abarzua, P.	17104.0005U2
	35.	10/177629	06/19/2002	Wiltshire, S.	17104.0006U2
	36.	09/931736	8/17/2001	Shao, W.	17104.0007U1
	37.	10/931015	8/31/2004	Shao, W.	17104.0007U2
	38.	11/870715	10/11/2007	Korfhage, C.	17104.0011U2
	39.	08/563912	11/21/1995	Lizardi, P.	25006.0001U1
	40.	09/132553	8/11/1998	Lizardi, P.	25006.0001U2
	41.	09/644723	8/23/2000	Lizardi, P.	25006.0001U3
	42.	09/132552	8/11/1998	Lizardi, P.	25006.0001U4
	43.	10/038718	1/2/2002	Lizardi, P.	25006.0001U5
	44.	10/896513	07/22/2004	Lizardi, P.	25006.0001U6
	45.	08/946732	10/8/1997	Lizardi, P.	25006.0003U1
	46.	09/397915	9/17/1999	Lizardi, P.	25006.0003U2
	47.	09/911226	7/23/2001	Lizardi, P.	25006.0003U3
	48.	10/700018	11/03/2003	Lizardi, P.	25006.0003U4
	49.	09/357487	7/20/1999	Lizardi, P.	25006.0004U2

Applicants submit for the Examiner's consideration, copies of Office Actions, Amendments, Responses, and other correspondence from the prosecution of the following

foreign patent applications. Pursuant to 37 C.F.R. § 1.98(a)(2)(iv), Applicants have enclosed a copy of each document. APPENDIX A lists these documents, provides identifying information, and includes a column for the Examiner's initials

INFORMATION DISCLOSURE STATEMENT LIST
pursuant to 37 C.F.R. § 1.98(a)(1)-(2) and (b)(4)
for Application No. 09/920,571 (Attorney Docket #: 17104.0001U2)
Disclosure of Foreign Patent Applications for which Applicants
provide prosecution-related documents (see APPENDIX A)

Initials	No.	Application #	Country	Filing Date	First Inventor	Attorney Docket
	1.	PCT/US02/02601	PCT	1/30/2002	Alsmadi, O.A	13172.0002P1
	2.	91102150	Taiwan	2/7/2002	Alsmadi, O.A.	13172.0002TW1
	3.	2001255331	Australia	4/12/2001	Faruqi, A.F.	13172.0003AU1
	4.	2405456	Canada	4/12/2001	Faruqi, A.F.	13172.0003CA1
	5.	1928481.9	EPC	4/12/2001	Faruqi, A.F.	13172.0003EP1
	6.	2001-577404	Japan	4/12/2001	Faruqi, A.F.	13172.0003JP1
	7.	PCT/US01/11947	PCT	4/12/2001	Faruqi, A.F.	13172.0003P1
	8.	2001269944	Australia	6/20/2001	Kingsmore, S.	13172.0004AU1
	9.	2411838	Canada	6/20/2001	Kingsmore, S.	13172.0004CA1
	10.	01811542.X	China P.R.	6/20/2001	Kingsmore, S.	13172.0004CN1
	11.	1948505.1	EPC	6/20/2001	Kingsmore, S.	13172.0004EP1
	12.	2002-503102	Japan	6/20/2001	Kingsmore, S.	13172.0004JP1
	13.	PCT/US01/19657	PCT	6/20/2001	Kingsmore, S.	13172.0004P1
	14.	200207285-8	Singapore	6/20/2001	Kingsmore, S.	13172.0004SG1
	15.	90114960	Taiwan	6/28/2001	Kingsmore, S.	13172.0004TW1
	16.	2001271722	Australia	7/2/2001	Ward, D.C.	13172.0005AU1
	17.	2411794	Canada	7/2/2001	Ward, D.C.	13172.0005CA1
	18.	1950759.9	Germany	7/2/2001	Ward, D.C.	13172.0005DE1
	19.	1950759.9	EPC	7/2/2001	Ward, D.C.	13172.0005EP1
	20.	1950759.9	Great Britain	7/2/2001	Ward, D.C.	13172.0005GP1
	21.	2002-508032	Japan	7/2/2001	Ward, D.C.	13172.0005IP1
	22.	PCT/US01/20933	PCT	7/2/2001	Ward, D.C.	13172.0005P1
	23.	PCT/US02/15045	PCT	5/10/2002	Nallur, G.	13172.0007P1
	24.	2002362874	Australia	10/15/2002	Bornarth, C.	13172.0012AU1
	25.	2463933	Canada	10/15/2002	Bornarth, C.	13172.0012CA1
	26.	2801776.2	EPC	10/15/2002	Bornarth, C.	13172.0012EP1
	27.	PCT/US02/33244	PCT	10/15/2002	Bornarth, C.	13172.0012P1

INFORMATION DISCLOSURE STATEMENT LIST
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Disclosure of Foreign Patent Applications for which Applicants
provide prosecution-related documents (see APPENDIX A)

Initials	No.	Application #	Country	Filing Date	First Inventor	Attorney Docket #
	28.	10240/97	Australia	11/21/1996	Lizardi, P.	13172.0013AU1
	29.	96940601.6	Belgium	11/21/1996	Lizardi, P.	13172.0013BE1
	30.	2236161	Canada	11/21/1996	Lizardi, P.	13172.0013CA1
	31.	96940601.6	Switzerland	11/21/1996	Lizardi, P.	13172.0013CH1
	32.	862656	Germany	11/21/1996	Lizardi, P.	13172.0013DE1
	33.	96940601.6	Denmark	11/21/1996	Lizardi, P.	13172.0013DK1
	34.	96940601.6	EPC	11/21/1996	Lizardi, P.	13172.0013EP1
	35.	96940601.6	France	11/21/1996	Lizardi, P.	13172.0013FR1
	36.	96940601.6	Great Britain	11/21/1996	Lizardi, P.	13172.0013GB1
	37.	96940601.6	Ireland	11/21/1996	Lizardi, P.	13172.0013IE1
	38.	9-519942	Japan	11/21/1996	Lizardi, P.	13172.0013JP1
	39.	96940601.6	Luxembourg	11/21/1996	Lizardi, P.	13172.0013LU1
	40.	96940601.6	Monaco	11/21/1996	Lizardi, P.	13172.0013MC1
	41.	96940601.6	Netherlands	11/21/1996	Lizardi, P.	13172.0013NL1
	42.	PCT/US96/18812	PCT	11/21/1996	Lizardi, P.	13172.0013P1
	43.	96940601.6	Sweden	11/21/1996	Lizardi, P.	13172.0013SE1
	44.	PCT/US03/00678	PCT	1/9/2003	Kumar, G.	13172.0015P1
	45.	27819/00	Australia	12/14/1999	Hafner, G.	13172.0017AU1
	46.	2394800	Canada	12/14/1999	Hafner, G.	13172.0017CA1
	47.	99969209.8	EPC	12/14/1999	Hafner, G.	13172.0017EP1
	48.	2000-588388	Japan	12/14/1999	Hafner, G.	13172.0017JP1
	49.	PCT/AU99/01110	PCT	12/14/1999	Hafner, G.	13172.0017P1
	50.	2003297891	Australia	12/11/2003	Kumar, G.	13172.0021AU1
	51.	2512196	Canada	12/11/2003	Kumar, G.	13172.0021CA1
	52.	3796961.5	EPC	12/11/2003	Kumar, G.	13172.0021EP1
	53.	2004-565385	Japan	12/11/2003	Kumar, G.	13172.0021JP1
	54.	PCT/US03/39430	PCT	12/11/2003	Kumar, G.	13172.0021P1

INFORMATION DISCLOSURE STATEMENT LIST
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Disclosure of Foreign Patent Applications for which Applicants
provide prosecution-related documents (see APPENDIX A)

Initials	No.	Application #	Country	Filing Date	First Inventor	Attorney Docket #
	55.	2001268725	Australia	6/27/2001	Lasken, R.	17104.0001AU1
	56.	2410951	Canada	6/27/2001	Lasken, R.	17104.0001CA1
	57.	1946712.5	Germany	6/27/2001	Lasken, R.	17104.0001DE1
	58.	1946712.5	EPC	6/27/2001	Lasken, R.	17104.0001 EP1
	59.	1946712.5	France	6/27/2001	Lasken, R.	17104.0001FR1
	60.	1946712.5	Great Britain	6/27/2001	Lasken, R.	17104.0001GB1
	61.	153097	Israel	6/27/2001	Lasken, R.	17104.0001IL1
	62.	1946712.5	Italy	6/27/2001	Lasken, R.	17104.0001IT1
	63.	2002/506247	Japan	6/27/2001	Lasken, R.	17104.0001JP1
	64.	PCT/US01/20217	PCT	6/27/2001	Lasken, R.	17104.0001P1
	65.	200253328	Australia	6/12/2000	Kingsmore, S.	17104.0002AU1
	66.	938263.1	EPC	6/12/2000	Kingsmore, S.	17104.0002EP1
	67.	469290-19	Japan	6/12/2000	Kingsmore, S.	17104.0002JP1
	68.	PCT/US00/16130	PCT	6/12/2000	Kingsmore, S.	17104.0002P1
	69.	2002/239809	Australia	1/4/2002	Bandaru, R.	17104.0003AU1
	70.	PCT/US02/00005	Canada	1/4/2002	Bandaru, R.	17104.0003CA1
	71.	2705674.6	EPC	1/4/2002	Bandaru, R.	17104.0003EP1
	72.	PCT/US02/00005	PCT	1/4/2002	Bandaru, R.	17104.0003P1
	73.	18040/01	Australia	11/28/2000	Abarzua, P.	17104.0004AU1
	74.	2360342	Canada	11/28/2000	Abarzua, P.	17104.0004CA1
	75.	980827	EPC	11/28/2000	Abarzua, P.	17104.0004EP1
	76.	469290-68	Japan	11/28/2000	Abarzua, P.	17104.0004JP1
	77.	PCT/US00/32370	PCT	11/28/2000	Abarzua, P.	17104.0004P1
	78.	2001/251359	Australia	4/5/2001	Abarzua, P.	17104.0005AU1
	79.	2405687	Canada	4/5/2001	Abarzua, P.	17104.0005CA1
	80.	1924731.1	EPC	4/5/2001	Abarzua, P.	17104.0005EP1
	81.	2001-575244	Japan	4/5/2001	Abarzua, P.	17104.0005JP1
	82.	PCT/US01/11151	PCT	4/5/2001	Abarzua, P.	17104.0005P1

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for Application No. 09/920,571 (Attorney Docket #: 17104.0001U2)
Disclosure of Foreign Patent Applications for which Applicants
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Initials	No.	Application #	Country	Filing Date	First Inventor	Attorney Docket #
	83.	PCT/US02/19443	PCT	6/19/2002	Wiltshire, S.	17104.0006P1
	84.	PCT/US02/27097	PCT	8/14/2002	Shao, W.	17104.0007P1
	85.	7118804.9	EPC	10/18/2007	Korfhage, C.	17104.0011EP1
	86.	2007-276942	Japan	10/24/2007	Korfhage, C.	17104.0011JP1
	87.	97915/98	Australia	10/8/1998	Lizardi, P.	25006.0003AU1
	88.	2308004	Canada	10/8/1998	Lizardi, P.	25006.0003CA1
	89.	98952147.1	EPC	10/8/1998	Lizardi, P.	25006.0003EP1
	90.	2000-515033	JP	10/8/1998	Lizardi, P.	25006.0003JP1
	91.	1100606.5	Hong Kong	1/27/2001	Lizardi, P.	25006.0003HK1
	92.	2000-515033	Japan	10/8/1998	Lizardi, P.	25006.0003W1
	93.	PCT/US98/21177	PCT	10/8/1998	Lizardi, P.	25006.0003P1
	94.	99935725.4	EPC	7/20/1999	Lizardi, P.	25006.0004EP1
	95.	PCT/US99/16373	PCT	7/20/1999	Lizardi, P.	25006.0004P1

Because the Examiner has not mailed a final action under MPEP § 1.113, Applicants believe that this Information Disclosure Statement is filed in a timely manner pursuant to 37 C.F.R. § 1.97(c)(2). Therefore, Applicants request that the Examiner consider the cited documents and make the same of record in the prosecution of this application (U.S. Patent Application No. 09/920,571).

Applicants enclose a Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$180.00, which represents the fee under 37 C.F.R. § 1.17(p). Applicants believe that this is the correct payment amount; however, Applicants hereby authorize the Commissioner to charge to Deposit Account No. 14-0629 any additional fees that may be required, or to credit any overpayment.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.



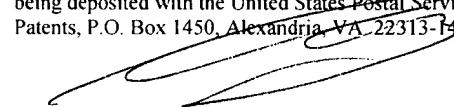
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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any mail stop request for continued examination items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.



Scott D. Marty, Ph.D.

7-2-08

Date